



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/672,852	09/26/2003	Jeyhan Karaoguz	15012US02	1267

23446 7590 01/26/2006

MCANDREWS HELD & MALLOY, LTD
500 WEST MADISON STREET
SUITE 3400
CHICAGO, IL 60661

EXAMINER

SMITH, JEFFREY A

ART UNIT PAPER NUMBER

3625

DATE MAILED: 01/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/672,852

Applicant(s)

KARAOGUZ ET AL.

Examiner

Jeffrey A. Smith

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 October 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 3625

DETAILED ACTION

Response to Amendment

The response filed October 31, 2005 has been entered and considered.

Claims 1-27 are pending.

Claims 2-5, 7, 9, 10, 13, 14, 16-18, 20, 26, and 27 are currently amended.

An action on the merits follows.

Drawings

The drawings were received on October 31, 2005. These drawings are approved.

Specification

The disclosure is objected to because of the following informalities: Applicant should provide the omitted application serial numbers for the U.S. applications listed at page 2 of the specification.

Appropriate correction is required.

Art Unit: 3625

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-7, 10, 11, 15-21, and 24 are rejected under 35 U.S.C. 102(e) as being anticipated by Novak (US 2003/0097655 A1).

Regarding claims 1 and 15

Novak discloses a system (see Fig. 1) providing support for user transaction on a media exchange network (par. [0002]).

The system comprises a television display (104) for consumption of media (par. [0082]); a storage (310) for storing media (par. [0077]), and having an associated network address (par. [0049]); set top box (see Fig. 3: 102) circuitry (308) communicatively coupled to deliver media from the storage to the television display (par. [0076]); an interface device (305) for

Art Unit: 3625

receiving from an authorization device (see Fig. 4: 410) associated with a user, information for authorizing a user transaction, the interface device communicatively coupled to the set top box circuitry (par. [0074]).

Novak further discloses (see Fig. 4) that the system comprises server software that receives, via a communication network, a request (409) comprising at least one of the associated network address, information identifying the user transaction, and at least a portion of the information for authorizing a user transaction (pars. [0049], [0088], and [0112]), and responds by enabling the completion of the identified user transaction without divulging the identity of the user to a vendor. For example, the Examiner notes (with reference to Fig. 4) an embodiment in which the verification of identity credentials includes checking the identity credentials with a trusted third party (TTP) (par. [0090]). A license key (412) and an access key (414) is all that is needed to decrypt the digital content (pars. [0096] and [0098]). These keys are received by the set top box (see Fig. 4 and par. [0030]). The set top box receives the digital content (404) from a content source (420). The user may obtain access to digital content based on the user's license (411) stored at the verification entity (406: in this case the trusted third party). The

Art Unit: 3625

license (411) is not tied to the user's set top box. The user may view the program using another set top box by simply inserting his or her smart card (410) and/or providing the necessary pass code, pass phrase, biometric data or the like (par. [0103]). In this manner the transaction is enabled without divulging the identity of the user to a vendor (either the broadcast center (110) or the sources (420) (par. [0099])).

Regarding claims 2 and 16

Novak discloses that the media comprises at least one of audio, a still image, video, real-time video, and data (par. [0082])).

Regarding claims 3 and 17

Novak discloses that consumption comprises at least one of playing audio, displaying a still image, displaying video, and displaying data (par. [0082])).

Regarding claim 4

Novak discloses that the associated network address is one of an Internet protocol (IP) address, a media access control (MAC) address, and an electronic serial number (ESN) (par. [0049])).

Art Unit: 3625

Regarding claims 5 and 18

Novak discloses that the communication network comprises at least one of a cable infrastructure, a satellite network infrastructure, a digital subscriber line (DSL) infrastructure, an Internet infrastructure, an intranet infrastructure, a wired infrastructure, and a wireless infrastructure (pars. [0052], [0053], and [0085]).

Regarding claims 6 and 19

Novak discloses that the communication network is the Internet (pars. [0057], [0060], [0084], [0085], and [0098]).

Regarding claims 7 and 21

Novak discloses that the interface device comprises one of an optical card reader, a magnetic card reader, a radio frequency identification (RFID) interface, an integrated circuit (IC) card interface, a biometric sensing device, and a cellular telephone (par. [0074]).

Art Unit: 3625

Regarding claims 10 and 20

Novak discloses that the user transaction comprises at least one of the storage, exchange, purchase, and consumption of media (par. [0082]).

Regarding claims 11 and 24

Novak discloses that the system further comprises a remote control communicatively coupled to the set top box (par. [0050]).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8, 9, 12-14, 22, 23, and 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Novak (US 2003/0097655 A1) in view of Russell et al. (US 2004/0044627 A1).

Art Unit: 3625

Regarding claims 8, 9, 22, and 23

As noted above, Novak discloses an interface device communicatively coupled to the set top box circuitry (see Fig. 4). Novak is silent as to the coupling mechanism being wired or wireless.

The Examiner notes, however, that Novak teaches that the authentication process may require the user (402) to enter additional information via the remote control (106). Such remote control may use infrared (IR), radio frequency (RF), or other wireless technologies to transmit control signals to the set top box (102) (par. [0050]). It is also noted that Novak teaches that the user may need to have current biometric data scanned by a biometric reading device, such as a fingerprint or retinal scanner, which is also sent with or following the request (409) for verification purposes (par. [0089]). Novak does not teach, however, that the biometric reading device is either integral with the remote control or that the reading device is wirelessly coupled to the set top box circuitry.

Regarding claims 12 and 25

The Examiner notes that Novak teaches that the authentication process may require the user (402) to enter additional information via the remote control (106) which

Art Unit: 3625

communicates the user transaction authorization information to the set top box circuitry (par. [0089]). Novak, however, does not teach that such authorization information is from an authorization device, per se. It is also noted that Novak teaches that the user may need to have current biometric data scanned by a biometric reading device, such as a fingerprint or retinal scanner, which is also sent with or following the request (409) for verification purposes (par. [0089]). Novak does not teach, however, that the remote control comprises the biometric reading device.

Regarding claims 13, 14, 26, and 27

The Examiner notes that Novak does not teach that the remote control comprises a scanning device to identify at least one of a product and a service.

Now comes Russell et al.

Russell et al. discloses a similar system providing support for user transaction on a media exchange network (see Abstract).

Russell et al. discloses a remote control in the form of a personal identifying device (PID) which is a portable device (par. [0182]) which is used to control access (par. [0060]) to entertainment systems (par. [0202]) in conjunction with applications exemplified by proprietary content browsing

(including pay television, pay audio, pay entertainment, royalty-based offerings such as ASCAP or other proprietary music offerings) (par. [0220]).

Regarding claims 8, 9, 22, and 23

Russell et al. teaches that the PID comprises a wireless coupling mechanism which comprises at least one of an infrared link (IR) and a radio frequency (RF) link (par. [0170]).

Russell et al. teaches that the PID may comprise both wired and wireless alternatives (par. [0171]).

Regarding claims 12 and 25

Russell et al. teaches that the PID comprise an interface device for receiving user transaction authorization information from an authorization device associated with a user (par. [0184]).

Regarding claims 13, 14, 26, and 27

Russell et al. teaches that the PID comprises a scanning device to identify at least one of a product and a service. The scanning device comprises one of an optical scanner and a radio frequency identification (RFID) interface (par. [0299]).

It would have been obvious to one of ordinary skill in the art to have modified the system of Novak to have included a remote control of the type and functionality taught by Russell et al. (thereby integrating the smart card reader of Novak in the disclosed remote control of Novak) in order to have provided a self contained, and portable remote control that can be carried on one's person (see Russell et al.: par. [0182]). Such self contained portability would have been especially advantageous and desirable in the scenario taught by Novak in which a person wishes to access digital content while away from their usual access location (see Novak: par. [0103]). In this scenario, it would not be necessary that the access location located away from their usual access location have an interface device associated with the access location because it would have been advantageously integrated into the portable remote control carried by the person.

Response to Arguments

Applicant's arguments filed October 31, 2005 have been fully considered but they are not persuasive.

Art Unit: 3625

Applicant's argument that the trusted third party (TTP) is a vendor by definition, and, therefore, cannot anticipate the claims is not persuasive.

The claims are read in context and in light of the specification. The "vendor" recited in the claims has been construed to mean "vendor of media". The claims have not been construed to mean "vendor of any good or service". This interpretation is a fair and reasonable interpretation when considering "the invention as a whole". The Novak TTP is established as a certification authority (CA) and is not established as a "vendor" of media. Even though Novak discusses an embodiment in which the TTP may sell licenses which grant access to media, the TTP, nonetheless, does not act in the capacity of "a vendor" or even a provider of the media itself.

Applicant's argument that "modifying the system of Novak to include a PID (i.e., a remote control of the type and functionality taught by Russell et al.) in place of the smart card reader and remote control of Novak would eliminate the ability to accept smart cards, rendering Novak non-functional in that respect" is not persuasive.

Novak teaches that the smart card/smart card reader is one example of establishing the identity of the user. The smart

Art Unit: 3625

card is not required in every embodiment (see Novak: par. [0087]). Novak teaches that identity verification bay be done using various techniques known in the art (par. [0087]).

Conclusion

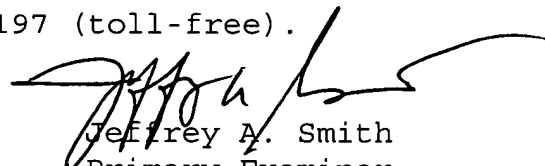
THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey A. Smith whose telephone number is (571) 272-6763. The examiner can normally be reached on M-F 6:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on (571) 272-7159. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jeffrey A. Smith
Primary Examiner
Art Unit 3625

jas